Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JACOBUS J.M. RUIGROK and GERARDUS H.J. SOMERS

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Appeal No. 2001-2262
Application 09/006,014

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ON BRIEF

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Before JERRY SMITH, DIXON, and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 6-15. Claims 1-5 have been cancelled. Claims 16-27 stand withdrawn from consideration by the examiner as a result of a restriction requirement.

The disclosed invention pertains to a multi-channel magnetic head using magnetoresistive measuring elements.

Representative claim 11 is reproduced as follows:

11. A multi-channel magnetic head having a head face which extends in a first direction and in a second direction transverse to the first direction, for scanning a record carrier which is relatively movable with respect to the magnetic head in the first direction,

comprising a structure of layers which extend respectively substantially in the second direction and in a third direction transverse to the first and second directions, said layers being disposed one on top of the other as viewed in the first direction,

said structure including a plurality of magnetoresistive sensors, each of said magnetoresistive sensors comprising a magnetoresistive measuring element, a first magnetic element and a second magnetic element respectively,

said magnetoresistive measuring elements being arranged such that, viewed in the second direction, adjacent magnetoresistive sensors are distinguishable; and, viewed in the first direction, the magnetic elements are opposite each other, at least the respective first magnetic elements extending as far as the head face,

characterized in that both magnetic elements of each of at least two adjacent magnetoresistive sensors are electrically conducting and have respective electric connection faces, the respective magnetoresistive measuring element being electrically arranged in series between the respective two magnetic elements for passing a measuring current through the measuring element substantially in the third direction.

The examiner relies on the following references:

Takino et al. (Takino)	4,896,235	Jan. 23, 1990
Ruigrok	5,973,889	Oct. 26, 1999

Claims 6, 7, 10, 11 and 13-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Takino. Claims 8, 9 and 12 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Takino taken alone. Claim 11 stands additionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Ruigrok in view of Takino.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support any of the examiner's rejections of the claims on appeal.

Accordingly, we reverse.

We consider first the rejection of claims 6, 7, 10, 11 and 13-15 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Takino. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he reads the claimed invention on the disclosure of Takino [answer, pages 3-4]. With respect to sole independent claim 11, appellants argue that magnetic elements 8F and 8B of Takino are not one on top of the other as claimed. Appellants also argue that the mere assertion by Takino that multi-channel heads may be formed fails to teach one how to make such a head [brief, pages 9-10]. The examiner responds by providing a diagram which, in the examiner's view, shows that elements 8F and 8B of Takino are on top of each other

as claimed. The examiner also refers to the portion of Takino which suggests a multi-channel modification [answer, pages 8-9]. Appellants respond that the examiner's diagram establishes a first direction which is contrary to the claimed invention. Specifically, appellants assert that the first direction defined by the examiner is not the direction of relative movement between the record carrier and the magnetic head as recited in claim 11 [reply brief, page 2].

We will not sustain the examiner's anticipation rejection of any of the claims based on Takino. As pointed out by appellants, the first direction defined by the examiner is indeed contrary to the claimed invention. Since Takino does not disclose every feature of the claimed invention, it does not anticipate the claimed invention. Since Takino does not anticipate independent claim 11, it also does not anticipate any of the claims which depend therefrom.

We now consider the rejection of claims 8, 9 and 12 under 35 U.S.C. § 103(a) based on Takino taken alone. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to

make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re

Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

The examiner's rejection is set forth on pages 5-6 of the answer. Although the examiner acknowledges that there are features of these claims which are not disclosed by Takino, the examiner dismisses these differences as being obvious to the artisan. Appellants argue that Takino teaches away from the claimed invention [brief, pages 12-13]. The examiner responds that appellants have failed to define the third direction in a manner which distinguishes over Takino and repeats the assertion that the differences between the claimed invention and Takino would have been obvious to the artisan [answer, pages 10-11].

We will not sustain the examiner's obviousness rejection of claims 8, 9 and 12. Since the examiner's rejection relies on an improper reading of the claimed invention on the disclosure of Takino for reasons discussed above, the examiner has failed to establish a prima facie case of obviousness. We also agree with

appellants that there are no teachings or suggestions within Takino that support the examiner's findings that the acknowledged differences between Takino and the claimed invention would have been obvious to the artisan.

We now consider the rejection of claim 11 under the judicially created doctrine of obviousness-type double patenting over claim 1 of Ruigrok in view of Takino. The examiner finds that claim 1 of Ruigrok recites the head structure of claim 11 except for the head being a multi-channel head. The examiner notes that Takino suggests a multi-channel head. The examiner finds that it would have been obvious to the artisan to modify a single channel head so that it becomes a multi-channel head as claimed [answer, page 3].

Appellants argue that the single channel head as taught by Ruigrok would never be modified to be a multi-channel head as claimed. Specifically, appellants argue that the dimensions of the single channel head in Ruigrok preclude its use as a multi-channel head because it would destroy the specific desirable properties of the single channel head. Appellants also argue that the mere mention of multi-channel heads in Takino does not teach the artisan that the single channel head of Ruigrok can be made into a multi-channel head as claimed. Finally, appellants

note that a patent granted on this application would expire before the Ruigrok patent anyway [brief, pages 5-9].

The examiner responds by repeating his assertion that it would have been obvious to the artisan to modify a single channel magnetic head so that it was a multi-channel head as taught by Takino. The examiner also responds that the rejection is made to prevent an unjustified or improper timewise extension of the Ruigrok patent [answer, pages 6-8].

We will not sustain this rejection of claim 11. Although the examiner refers to an improper timewise extension of the patent, he does not address the fact that a patent granted on this application would in fact expire before the Ruigrok patent. Nevertheless, we agree with appellants that there is nothing on this record which would motivate the artisan to turn the single channel head of Ruigrok into a multi-channel head. The mere fact that some single channel heads can be replicated to form multi-channel heads does not mean that all such single channel heads can be so modified. We agree with appellants that the particular single channel head of Ruigrok, which is specifically designed for single channel use, cannot simply be transformed into a multi-channel head as proposed by the examiner. The examiner has not addressed the argument that the specific properties of the

Ruigrok single channel head would be lost if the head were modified to be a multi-channel head.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 6-15 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)	
JOSEPH L. DIXON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

JS:pgg

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